



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,557	05/21/2001	Jacek Kowalski	1400.002	3728

7590 10/22/2003

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, L.L.C.
US BANK BUILDING, SUITE 2000
777 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202

EXAMINER

CASIANO, ANGEL L

ART UNIT	PAPER NUMBER
----------	--------------

2182

DATE MAILED: 10/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,557

Applicant(s)

KOWALSKI ET AL.

Examiner

Angel L. Casiano

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The present Office action is in response to Amendment dated 05 August 2003.
2. Claims 1-7 and 9-13 are pending in the application.

Specification

3. Previous objection to the title has been overcome with the corrections included in the present amendment.
4. Applicants claim benefit under 35 U.S.C. 119 (a)-(d). The reference information related to the claimed priority should be incorporated into the Specification, as part of page 1, line 1.
5. Objection to the Specification due to minor informalities has been overcome with the correction filed in the present Amendment.

Claim Rejections - 35 USC § 112

6. Rejections under 35 U.S.C. § 112, second paragraph, have been overcome with the corrections presented in the Amendment.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2182

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timson et al. [US 6,041,412] in view of Kenneth et al. [US 5,594,233].

Regarding claim 1, Timson et al. teaches a reader (see Fig. 1) for chip card (see Fig. 1, "50","60"). The reader includes a central processing unit (see col. 7, line 44) for emitting (see Fig. 1, "10") and receiving (see Fig. 1, "5") information. This communication is in a format determined by a communication protocol (see col. 8, lines 39-40) for contact chip card. The reader found in the prior art teaches a card-receiving device (see Fig. 1, "DR") including a contact card connector (see col. 7, lines 65-66) connected to the CPU (see Fig. 1, "2"). It is also disclosed a reading device for contactless chip cards including an interface (see col. 8, lines 52-54; Fig. 2, "82"). The interface for the contactless reading device is directly connected to a communication bus (see Fig. 2). The contactless reading device is arranged in hardware (see Fig. 2) and software (see col. 8, line 62). However, the reference does not explicitly disclose a communication bus. Nonetheless, Fig. 1 teaches emitting and receiving data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the elements in Fig. 1 via a communication bus, since it well known in the art the use of a bus for transmission and reception purposes. Although the

reference does not expressly teach the emission or reception of binary messages, one of ordinary skill in the art at the time the invention was made would have applied the reference to binary data. Transmission and reception of binary messages is well known in the art. In addition, the reference does not teach a specific contact chip card activation command or a specific activation command. Nonetheless, the prior art teaches the activation of the contact chip card reading device and contactless card reading device. The reference also teaches responding to the activating instructions (see Figs 3, 5; col. 9, lines 1-5, 37-40). The contact and contactless chip cards respond only to their activation signals and devices, and not to the signal and devices intended to activate the other chip card type. In addition, Kenneth et al. teaches a chip card reading system having automatic recognition of the card modes (see Abstract). The chip card system disclosed teaches a response to a specific activation command (see col. 5, lines 20-23) for a contactless card. This command is different from the activation command for the contact chip card. Kenneth et al. does not explicitly cite two formats determined by a communication protocol. However, it does teach the application of a communication protocol for different card formats (see col. 2, lines 15-22). One of ordinary skill in the art would have been motivated to specify message conversion in order to properly enable data read/write functionality, as cited by Kenneth et al. The cited prior art determines the appropriate communication protocol in order to enable these functionalities. As it is well known in the art, message conversion is often required in order to obtain data compatibility. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both references in order to have a chip card reader that automatically recognizes a contactless chip card (see Kenneth et al.; col. 2, lines 41-44).

Art Unit: 2182

As for claim 2, the combination of references teaches a supply wire (see Kenneth et al.; col. 1, lines 59-61). The cited wire supplies the read head electrically.

As for claim 3, the combination of references does not explicitly teach an inhibition state for the card reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device is not activated unless a signal is received (see Kenneth et al.).

As for claim 4, the combination of references teaches a central processing unit (see Timson et al.; Fig. 1, "2"). The CPU controls the card detection and activation commands (see col. 8, line 7). Nonetheless, the references do not explicitly disclose the specific operations performed by the CPU (see col. 9, lines 3-4). However, the CPU controls the contact card activation and communication (see Fig. 3, "92"; col. 9, lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made, that in order to control as disclosed, the contact card, an activation command must have been sent and a response would have been received. Accordingly, the CPU controls the contactless card activation and its communication with the processing unit (see Fig. 3, "92"; col. 8, lines 52-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to control, as disclosed, the contactless card, an activation command

Art Unit: 2182

must have been sent and a response would have been received (inherent, Kenneth et al.; col. 5, lines 20-24).

As for claim 5, Timson et al. does not disclose the contact card activation command as a reset command according to the ISO 7816 standard. Nonetheless, Kenneth et al. discloses an activation signal for a contact card mode (see col. 1, lines 59, 64; col. 6, lines 50, 60-61). This activation signal is a reset signal. This command is in accordance to the ISO 7816 standard (see col. 2, lines 16-22).

As for claim 6, the limitation of the specific activation command for the contactless card “likely to be never sent to a contact chip card” is taught by the combination of references. In the combination of references, the detection and activation devices for both card types are different and separated (see Figs. 1, 2, 3; col. 8, lines 52-57).

As for claim 7, the limitation of “the specific activation command is a signal sent on a bus, which is not used by contact ship cards”, is taught by the combination of references. The combination of references teaches detection and activation devices for both card types as different and separate (see Figs. 1, 2, 3; col. 8, lines 52-57).

As for claim 9, the combination of references teaches the contactless reading device as integrated in a circuit arranged inside the card-receiving device (see Timson et al., Fig. 1, “DR”; see Fig. 2, “82”).

Regarding claim 10, Timson et al. discloses a reading device for contactless chip cards including an interface (see col. 8, lines 52-54; Fig. 2, "82"). The interface for the contactless reading device (read head) is directly connected to a communication bus for receiving or emitting messages (see Fig. 2). This communication is in a format determined by ISO 7816 protocol (see col. 8, lines 39-40). However, the prior art does not explicitly teach an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device is not activated unless a signal is received. In addition, Kenneth et al. teaches a chip card reading system having automatic recognition of the card modes (see Abstract). The chip card system teaches a response to a specific activation command (see col. 5, lines 20-23) for a contactless card. This command is different from the activation command for the contact chip card. Kenneth et al. does not explicitly cite two formats determined by a communication protocol. However, it does teach the application of a communication protocol for different card formats (see col. 2, lines 15-22). One of ordinary skill in the art would have been motivated to specify message conversion in order to properly enable data read/write functionality, as cited by Kenneth et al. The cited prior art determines the appropriate communication protocol in order to enable these functionalities. As it is well known in the art, message conversion is often required in order to obtain data compatibility. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

combine both references in order to have a chip card reader that automatically recognizes a contactless chip card (see Kenneth et al.; col. 2, lines 41-44).

As for claims 11 and 12, the combination of references teaches a contactless card that responds only to the specific activation command (see Figs. 1, 2, 3; col. 8, lines 52-57; Kenneth et al., col. 5, lines 20-23). The reference does not explicitly teach an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made, that the contactless reading device is in inhibition state when the activation command is not received, since the reading device not activated unless a signal is received.

As for claim 13, the combination of references does not expressly disclose an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Timson et al., Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device not activated unless a signal is received. Accordingly, a return to the inhibition state would have been defined when the activation signal is not received on the interface disclosed by Timson et al.

Response to Arguments

9. Applicant's arguments with respect to claims 1-7 and 9-13 have been considered but are moot in view of the new ground(s) of rejection. New grounds of rejection are provided in view of the present amendment.

10. However, in response to applicant's argument that Timson et al. does not teach two readers sharing the same data wire of the same communication bus (Page 9), Examiner respectfully notes that this is not claimed. Regarding this argument, claim 1 merely cites a contact card connector connected to the communication bus as well as a serial interface connected "at least to a data wire of said communication bus". Therefore, these are connected via the same bus but are not exposed as sharing the same data wire of the bus. In another aspect of claim 1, applicants argue that Timson et al. does not teach a CPU having means for emitting and receiving binary messages having a first format determined by a communication protocol for contact chip card (Page 9). Nonetheless, on the same page it is admitted that "each reader is linked to the CPU via a specific bus". It is noted that applicant makes reference to the contactless card reader "8" and contact card reader "9". In addition, Examiner respectfully states that Timson et al. suggest a standardized protocol for both readers. The cited reference discloses the use of the ISO 7816 standard. Applicant cites the ISO 7816 standard when disclosing a command, in claim 5. In re DeLisle, 160 USPQ 806 (CCPA 1969) states that a reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art.

Regarding applicant's argument that Berger does not teach means for converting messages, as defined in claim 1, Examiner agrees. In accordance, new grounds of rejections are provided in

Art Unit: 2182

view of new prior art. In re McLaughlin, 170 USPQ 209 (CCPA 1971) establishes that the test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Yacoob [US 6,557,752 B1] teaches smart card for recording transactions.
- Sehr [US 2001/0018660 A1] discloses electronic ticketing system.
- Bashan et al. [US 6,045,043] teaches contact/contactless data transaction card.
- Deo et al. [US 5,721,781] discloses authentication system and method for smart card transactions.
- Pieterse et al. [US 5,714,741] discloses device for transparent interaction between an IC card and a remote terminal.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2182


the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 8:00-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

alc
October 16, 2003


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Application/Control Number: 09/786,557

Art Unit: 2182

Page 12